

32692

Customer Number

Patent
Case No.: 58821US006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: YOKOYAMA, CHIKAFUMI
Application No.: 10/595093 Confirmation No.:
Filed: August 17, 2004 Examiner:
Title: PRECURSOR PASTE AND METHOD OF PRODUCING THE SAME

DECLARATION OF CAROLYN A. FISCHER
IN SUPPORT OF 35 CFR § 1.47 (b)

I, Carolyn A. Fischer, state as follows:

1. I am a Patent Agent with the 3M Innovative Properties Company, the Assignee of the above-identified application (hereinafter "the present application").
2. I prepared Attorney Docket No. 58821US006, also identified as U.S. patent application serial no. 10/595093, which is a national stage submission of PCT/2204/026701 having an international filing date of August 17, 2004 that claims priority under 35 USC § 119 to JP-2003-208442, filed August 22, 2003.
3. On June 5, 2006, I sent a copy of patent application Attorney Docket No. 58821US006 along with the Assignment as well as the Declaration and Power of Attorney to Toshio Tamura, the Manager of the Intellectual Property Department of Sumitomo-3M, to obtain the signature of the inventor, Chikafumi Yokoyama, a former employee of Sumitomo 3M Ltd.
4. On June 7, 2006, I received the attached written statement from Toshio Tamura stating that Yokoyama-san had refused to sign the Assignment as well as the Declaration and

Power of Attorney documents in connection with patent application Attorney Docket No. 58821US006.

5. On June 19, 2006, I received a decision in response to a petition under 37 CFR §1.47(a) in connection with attorney docket no. 58343US005, that Toshio Tamura's statement was not in compliance with MPEP409.03(d).

6. I personally sent Chikafumi Yokoyama the attached e-mail on August 28, 2006 inquiring about his refusal to sign documents in connection with four U.S. patent applications, Attorney Docket Nos. 58821US006, 58343US005, 59452US005, and 60320US002. I included as attachments each of the patent applications along with the Assignment as well as the Declaration and Power of Attorney for each of these patent applications.


7. On August 30, 2006 I received the attached e-mail reply from Chikafumi Yokoyama that he refused to sign the patent documents pertaining to Attorney Docket No. FN59452US005 because he did not agree with the inventorship.

8. On August 31, 2006 I sent the attached e-mail explaining that it was my understanding that Jim Lilly, a US Patent Attorney had investigated the inventorship of Attorney Docket No. FN59452US005 and found no evidence that the inventorship was incorrect. I also inquired about Chikafumi Yokoyama's reason for not signing the documents in connection with Attorney Docket Nos. 58821US006, 58343US005, and 60320US002.

9. On September 14, 2006 I sent the attached follow-up e-mail.

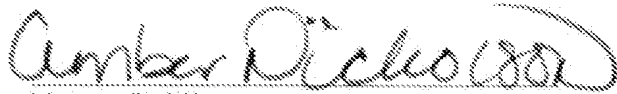
10. Since I have not received any additional correspondence from Chikafumi Yokoyama since his August 30, 2006 e-mail, I have concluded that his lack of response substantiates Toshio Tamura's statement that Chikafumi Yokoyama has refused to sign the documents in connection with Attorney Docket Nos. FN59452, FN 58821US006, 58343US005, and 60320US002.

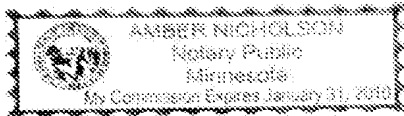
FURTHER AFFIANT SAITH NOT.


Carolyn A. Fischer

Subscribed and sworn to before me, this

25th day of September, 2006


Notary Public





Carolyn A.
Fischer/LA-Legal/3M/US
09/14/2006 02:32 PM

To "Chikafumi Yokoyama" <yokoyama@reprocell.com>
cc
bcc
Subject Fw: 3M Patent Application Documents

In the event that you did not receive my reply to your e-mail of 8-30-2006, I am forwarding such reply to your attention. I understand that you do not agree with the inventorship determination of FN59452US005. However, it was previously determined that although Hiroshi Kikuchi may not have collaborated with you directly, he collaborated with Akira Yoda in the conception of at least one of the patent claims.

Do you also disagree with the inventorship of 58821US006, 58343US005, and 60320US002 or are you simply unwilling to cooperate?

3M Office of Intellectual Property Counsel
Mail Address: 220-9E-01 Office Location: 220-9-SW26
Tel: 651/575-3915 Fax: 651-736-3833
This communication contains confidential information intended only for the addressee(s) named below and may contain information that is legally privileged.

----- Forwarded by Carolyn A. Fischer/LA-Legal/3M/US on 09/14/2006 02:21 PM -----



Carolyn A.
Fischer/LA-Legal/3M/US
08/31/2006 03:57 PM

To "Chikafumi Yokoyama" <yokoyama@reprocell.com>
cc
Subject Re: 3M Patent Application Documents

3M Office of Intellectual Property Counsel
Mail Address: 220-9E-01 Office Location: 220-9-SW26
Tel: 651/575-3915 Fax: 651-736-3833
This communication contains confidential information intended only for the addressee(s) named below and may contain information that is legally privileged.

Thank-you very much for your timely response.

It is my understanding that Jim Lilly investigated the inventorship of the FN59452US005 patent application around the time this case was filed and found no evidence to support that the inventorship was incorrect. Would it be helpful if I explained the US law as it relates to joint inventorship?

Is it your position that you will not sign the documents for 58821US006, 58343US005, and 60320US002 unless I delete Hiroshi Kikuchi as an inventor on FN59452US005?

"Chikafumi Yokoyama" <yokoyama@reprocell.com>



"Chikafumi Yokoyama"
<yokoyama@reprocell.com>
08/30/2006 09:43 PM

To <cafischer@mmm.com>
cc
Subject Re: 3M Patent Application Documents



Dear Sir/Madam

Thank you very much for your e-mail.

It is true that Mr. Tamura asked me to put my signature on the patent application of FN59452US005 as an inventor and then that I refused to do it.

When I read through the patent application before putting my signature, I thought that the patent was composed of two ROIs (RI03054 and RI04017) in which my name alone is written as an inventor. However, the other two names were added in the patent as inventors: Akira Yoda and Hiroshi Kikuchi. Therefore, I asked Mr. Tamura to investigate who should be the inventors in the patent.

He made an effort to investigate it and answered that the patent was composed of three ROIs: RI03054 (C.Yokoyama, as an inventor), RI04017 (C. Yokoyama) and RI04082 (A. Yoda).

I replied to him that if his investigation is true then the inventors should be C. Yokoyama and A. Yoda alone and that the name of H. Kikuchi should be deleted as an inventor. In addition, I said that unless description of the inventors in the patent is revised then I will not put my signature.

Afterward, Mr. Tamura replied that US attorney made the decisions to make no revision in the patent and to submit it without my signature.

I think the first things to do for 3M company and the US attorney are to investigate the truth and then to go into action with sincerity and accountability.

Best regards

Chikafumi Yokoyama, PhD
CEO
ReproCELL, Inc.
Tel: +81-3-3519-6559
Fax: +81-3-3501-3590
E-mail: yokoyama@reprocell.com
Homepage: www.reprocell.com

----- Original Message -----
From: <cafischer@mmm.com>
To: <yokoyama@reprocell.com>
Cc: <ttamura@mmm.com>

Sent: Tuesday, August 29, 2006 4:41 AM
Subject: 3M Patent Application Documents

> 3M Office of Intellectual Property Counsel
> Mail Address: 220-9E-01 Office Location: 220-9-SW26
> Tel: 651/575-3915 Fax: 651-736-3833
> This communication contains confidential information intended only for the
> addressee(s) named below and may contain information that is legally
> privileged.
>
>
> Dear Mr. Chikafumi Yokoyama,
>
> It is my understanding that Toshio Tamura has presented you with a copy of
> the patent application papers to obtain your signature on Assignment
> documents as well as Declaration and Power of Attorney documents for
> submission to the United States Patent and Trademark Office pertaining to
> U.S. Patent Application Attorney docket numbers 58821US006, 58343US005,
> 59452US005, and 60320US002. In the event that you do not recall these
> applications and documents, I've attached a copy of each.
>
> Is it true that you have refused to sign these documents?
>
>
>
> (See attached file: 58821US006 Formal Papers Missing Parts.doc) (See
> attached file: 58821WO and TW Application.doc) (See attached file:
> 58343WO003 App.doc) (See attached file: 58343US005 Formal Papers missing
> parts.doc) (See attached file: 59452US005 Application.doc) (See attached
> file: 59452US005 Formal Papers Missing Parts.doc)
> (See attached file: 60320US002-S3M-04053.doc) (See attached file:
> 60320US002
> Formal Papers.doc)

Statement

I, Toshio Tamura, personally contacted Yokoyama-san on June 6, 2006 to obtain the signature of Chikafumi Yokoyama on the Assignment as well as the Declaration and Power of Attorney documents for Attorney docket number 58821US006. Yokoyama-san refused to sign the documents.

Toshio Tamura June 7, 2006

Toshio Tamura ;

Date

32692
Customer Number

Patent
Case No.: 58821US006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: YOKOYAMA, CHIKAFUMI
Application No.: 10/595093 Confirmation No.: 2464
Filed: August 17, 2004
Title: PRECURSOR PASTE AND METHOD OF PRODUCING THE SAME

35 USC § 1.47 (b) PETITION TO FILE ON BEHALF OF AN INVENTOR

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. §1.47(b) and 35 U.S.C. §116, second paragraph, Applicant submits this Petition seeking permission to file the above-identified application on behalf of and as agent for Chikafumi Yokoyama, the sole inventor, who has refused to execute the application.

As evidenced by the attached Declaration of Carolyn A. Fischer, Applicant has made a bona fide attempt to present the above-identified patent application and corresponding Declaration and Power of Attorney to Chikafumi Yokoyama and he has refused to sign for this application.

3M Innovative Properties Company has the right to file the above-identified patent application on behalf of and as agent for the inventor by virtue of the attached employment agreement between Chikafumi Yokoyama and Sumitomo 3M Limited virtue of an agreement between Sumitomo 3M, Ltd. and 3M Innovative Properties Company, as acknowledged in the attached statement of Steven E. Skolnick.

The acceptance of this petition in lieu of an executed Declaration is necessary to prevent the patent application from going abandoned.

The last known address of Chikafumi Yokoyama is 6-25-30, Minami-Kurihara, Zama-shi, Kanagawa, 228-0015, Japan

In accordance with MPEP 409.03(a), Applicant has included an unsigned oath accompanied by this petition to accept the application on behalf of and as agent for Chikafumi Yokoyama. The required fee provided in 37 C.F.R. §1.17(h) will be paid at the time of EFS-Web submission. Please also charge any additional fees or credit any overpayment to Deposit Account No. 13-3723.

Respectfully submitted,

September 25, 2006

Date

By: /Carolyn A. Fischer/

Carolyn A. Fischer, Reg. No.: 39,091

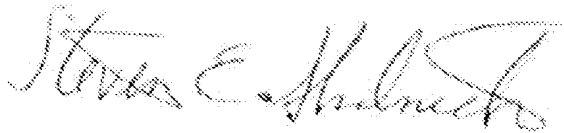
Telephone No.: 651-575-3915

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833



ACKNOWLEDGEMENT OF PATENT RIGHTS

I, Steven E. Skolnick, Chief Intellectual Property Counsel, Sumitomo 3M Limited, acknowledge that, by virtue of an agreement between Sumitomo 3M Limited, a company organized under the laws of Japan, and 3M Innovative Properties Company, a corporation organized and existing under the laws of the State of Delaware, United States of America, located at 3M Center, Saint Paul, Minnesota U.S.A., having an effective date of January 1, 2002, 3M Innovative Properties Company has all rights and interests throughout the world to apply for and obtain patent rights for the invention entitled "PRECURSOR PASTE AND METHOD OF PRODUCING THE SAME", U.S. Serial No. 10/595093, which is a national stage submission of PCT/US2004/026701 having an international filing date of August 17, 2004 that claims priority under 35 USC § 119 to JP-2003-208442, filed August 22, 2003.



Steven E. Skolnick
Chief Intellectual Property Counsel
Sumitomo 3M Limited

Dated: September 22, 2006

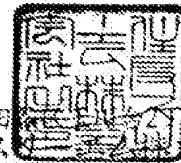
Certification of Document

KNOW ALL MEN BY THESE PRESENTS:

THAT we, Sumitomo 3M Limited, a company duly organized and existing under the laws of Japan, having its principal place of business 33-1, Tamagawa-dai 2-chome, Setagaya-ku, Tokyo 158-8583, Japan hereby, certify that the document attached to this certification is a truly copy of the original of Secrecy Agreement.

IN WITNESSETH WHEREOF, we, Sumitomo 3M Limited, have caused our name to be subscribed and sealed hereto by Paul D. Rosso, President and this Certification of Document to be duly executed as of this April 5, 2005.

東京都世田谷区田33番1号
住友スリーエム株式会社
代表取締役 ボール・ディー・ロッソ



SECRECY AGREEMENT

Employee's name Chikafumi Yokoyama

Initially assigned to Corporate Development Laboratory
Division or Department

In this Agreement:

- a. *Employer* means Sumitomo 3M Ltd., a corporation of Japan having its principal office in Tokyo.
- b. *Confidential Information* means information, not generally known, and proprietary to *Employer*, including trade secret information about *Employer's* processes and products, including information relating to research, development, manufacture, purchasing, accounting, engineering, marketing, merchandising, selling, leasing, servicing, finance and business systems and techniques, or similar information of a third party who has entrusted such information to *Employer* but excluding information which shall have become publicly available not through the fault of myself. All information disclosed to me, or to which I obtain access, whether originated by me or by others, during the period of my employment, which I have reasonable basis to believe is *Confidential Information*, or which is treated by *Employer* as *Confidential Information*, shall be presumed to be *Confidential Information*.
- c. *Inventions* mean discoveries, improvements and ideas and works of authorship (regardless of whether or not patentable or copyrightable) relating in any way to the business or activities of *Employer* based upon other technology, trade secrets, or know-how than listed below pursuant to paragraph (2).

I am employed or desirous of being employed by *Employer* in such capacity that, whether or not engaged directly in manufacturing, sales, or research and development activities, by the nature of my duties I expect to become informed of *Confidential Information* and may contribute thereto.

In consideration of and as part of the terms of my employment and/or continued employment (as the case may be), and the payment of salary to me therefor by *Employer* during such time as may be mutually agreeable to myself and *Employer*:

- (1) With respect to all *Inventions* made or conceived by me (either solely or jointly with others) during the period of my employment by *Employer* and within one (1) year of the termination of my employment:
 - a) I agree to promptly and fully inform *Employer* in writing.
 - b) I hereby assign and agree to assign to *Employer* all of my rights to all such *Inventions*, and to all Applications for Letters Patent, Utility Model, Design and/or Copyright in all countries and to Letters Patent, Utility Model, Design and/or Copyright granted thereupon covering all such *Inventions*.
 - c) I agree, promptly upon request by *Employer*, to execute, acknowledge and deliver to *Employer* such written instruments and do such other lawful acts as may be necessary in the opinion of *Employer* and/or its Counsel, to obtain and maintain the entire right, title and interest thereto in *Employer*.
 - d) I agree to accept reasonable compensation for the *Invention* taking into consideration the nature of my employment, the length of employment and the salary and other compensation which I am currently receiving.
- (2) I agree that I will at no time hereafter assert any trade secret, copyright, patent or any rights under any invention, improvement, know-how or idea as having been made or acquired by me prior to my employment by *Employer* except as listed below.
- (3) I agree that all records of *Confidential Information* prepared by me or which come into my possession are the property of *Employer* and when my employment shall terminate all such records

and all copies thereof shall be left with *Employer*.

- (4) Except as required in my duties to *Employer*, I agree that I will not, either during my employment by *Employer* or thereafter, directly or indirectly use or disclose to others any *Confidential Information* without first obtaining the written consent of *Employer* to do so until *Confidential Information* shall have become publicly available not through the fault of myself.
- (5) I am hereby advised that *Employer* does not desire to receive any confidential information in breach of my obligation to others and, I agree that, as an employee of *Employer*, I will not disclose to *Employer* or use in the performance of my duties for *Employer*, any confidential information in breach of my obligation to any third party.
- (6.01) In addition to my agreement set forth in (4) above and in addition to the limitations imposed by law upon the use or disclosure to others by me of *Confidential Information*, I further agree that, if my employment by *Employer* shall terminate for any reason, I will not for a period of two (2) years after termination of my employment with *Employer*, without first obtaining the written permission of *Employer*, directly or indirectly perform services for:
 - a) any person, firm, corporation or entity engaged (or about to become engaged) in the production and/or sale of any product with which at any time during my employment by *Employer* my work has been concerned or in respect to which I have acquired *Confidential Information* as a result of my said employment; or
 - b) any firm or corporation which is the parent, subsidiary or affiliate of such firm or corporation.
- (6.02) If I am unable to obtain employment consistent with my abilities and education, within one month after termination of my employment with *Employer*, solely because of the provisions of paragraph (6.01) hereof, such provisions shall thereafter continue to bind me only as long as *Employer* shall make payments to me equal to my monthly base pay at termination (exclusive of extra compensation, bonus or employee benefits), for each month of such unemployment, commencing with the second month after termination of my employment with *Employer*.
- (6.03) I agree that I will, during each month of such unemployment, make conscientious and aggressive efforts to find employment; and I will, within ten days after the end of each calendar month, give *Employer* a detailed written account of my efforts to obtain employment. Such account will include a statement by me that although I aggressively sought employment, I was unable to obtain employment solely because of the provisions of this paragraph (6.01).
- (6.04) It is understood that *Employer* shall, at its option, be relieved of making a monthly payment to me for any month during which I failed to seek employment conscientiously and aggressively, and to account to *Employer*, as provided for above.
- (6.05) *Employer* is obligated to make such payments to me, upon my fulfillment of the conditions set forth above, for 23 consecutive months unless *Employer* gives me written permission to accept available employment, or gives me a written release from the obligations of paragraph (6.01) hereof.
- (6.06) *Employer's* obligation to make such monthly payments shall terminate upon my death or upon my obtaining employment. I agree that I will give prompt written notice of such employment to *Employer*.
- (6.07) *Employer* shall not be liable, under this Agreement, or in any action relating thereto, for any amount greater than the equivalent of 23 such monthly payments, less amounts paid to me by *Employer* pursuant to this Agreement, *Employer* not being obliged to make a payment to me for the first month of such unemployment.
- (6.08) If, after termination of my employment with *Employer*, I obtain other employment but solely because of the provisions of this paragraph (6.01), my position is such that my monthly base pay is less than that which I last received from *Employer* as monthly base pay at termination, then

Employer's obligation to make payments to me for the period specified in paragraph (6.05) will be limited to the difference between my monthly base pay at Employer, at termination, and the monthly base pay I receive in my subsequent employment.

- (7) I agree that my obligations under this Agreement shall be binding upon my heirs, assigns and legal representatives, and shall inure to the benefit of the successors and assigns of Employer.
- (8) The Tokyo District Court shall have jurisdiction over all controversies which may arise with respect to the execution, interpretation and performance of this Agreement.

Signed and sealed at head office

this 1st day of August

C. Yokoyama (seal)
Employee's name

Chikafumi Yokoyama

Employee's home address

12-41-102, Suge 5-chome, Tama-ku, Kawasaki-Si,
Kanagawa-ken

WITNESS: [Signature]

Residing at: Setagaya-ku, Tokyo

WITNESS: [Signature]

Residing at: 683-9 Kisomachi, Machida City, Tokyo

Accepted for Employer at _____ this _____ day of _____

_____ by the undersigned, acting under authority from the Board of Directors of
Sumitomo 3M Ltd.

M. Pyahis
(Signature of Authorized Representative)
Title: Human Resources Manager

ATTEST: [Signature]

Exceptions, if any, to paragraph (2): (If none, indicate none.)